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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,237	07/17/2007	Kenji Kawai	358362011400	7341
25227 7590 03/16/2010 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
FERGUSON, LAWRENCE D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,237

Applicant(s)

KAWAI ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 6-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 2/19/10

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed January 15, 2010. Claims 1 and 6 were amended and claim 10 was added rendering claims 1-10 pending, with claim 5 withdrawn as a non-elected invention.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 102(b)

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenji et al. (JP 2003-291282).

Kenji discloses a polyolefin laminate film comprising a biaxially oriented polypropylene base layer and a polyolefin sealing layer which is formed on at least one surface of the base layer (abstract, paragraphs 0004-0005 and claim 1). Because Kenji

discloses a polyolefin laminate film with the same materials and size configuration, as shown in Figure 1 of Kenji, it is inherent for the film of Kenji to have the same width direction thickness variation rate and product takeout width as claimed, which would result in the film of Kenji having the same formula as in claims 1-2.

Concerning claims 3-4, Kenji discloses the sealing and substrate layers comprise antifogging agents (paragraph 0013 and claims 1-2).

5. Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited film further including the film wound into a roll having a takeout width of not less than 500 mm and a length of not less than 2000m. Additionally, the closest prior art does not teach or suggest the recited film further including a thickness variation Z (%) of not less than 3% and not more than 15%. The closest prior art does not teach or suggest a film roll of the polyolefin laminate film further including wherein the polyolefin laminate film of the roll has a product takeout width of not less than 500mm and a length of not less than 2000m.

The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Response to Arguments

6. The objection of claim 1 is withdrawn due to Applicant correcting the punctuation as requested. The objection of claim 6 is withdrawn due to Applicant cancelling claim 6's dependency on claim 3, which was a multiple dependent claim.

Applicant's arguments of the rejection made under 35 U.S.C. 102(b) as being anticipated by Kenji et al. (JP 2003-291282) have been considered but are unpersuasive. Applicant argues Kenji does not meet the formula as disclosed in claim 1, because the film of Kenji is made using a different process. Examiner maintains Because Kenji discloses a polyolefin laminate film with the same materials and size configuration, as shown in Figure 1 of Kenji, it is inherent for the film of Kenji to have the same width direction thickness variation rate and product takeout width as claimed, which would result in the film of Kenji having the same formula as in claims 1-2. Although the method of making the film of Kenji is not identical to the method of making the instantly claimed invention, the recited steps imply a structure having an oriented base layer and a sealing layer, where the reference suggests such a product because Kenji discloses a polyolefin laminate film with the same materials and size configuration, as shown in Figure 1 of Kenji. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/
Patent Examiner, Art Unit 1794

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794